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Examiner

James A. Reagan

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Reply Brief-16 pages

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DOCKET NO. EN919990079US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: R.F. Gloor *et al.*) Examiner: James A. Reagan
Serial No.: 09/439,310)
Filed: 11/12/1999) Art Unit: 3621

For: **BUSINESS METHODS FOR QUALITY ASSURANCE OF SERVICES**

Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF OF APPELLANTS

This Reply Brief, which addresses issues raised in Examiner's Answer mailed March 11, 2003, discusses the Examiner's Grounds of Rejection and the Examiner's Response to Appellants' Arguments with respect to the three issues under appeal:

Issue 1): Whether claims 1, 2, and 4 are anticipated by Eisener under 35 U.S.C. §102(b);

Issue 2): Whether claim 4 is directed to non-statutory subject matter under 35 U.S.C. §101;

Issue 3): Whether claim 4 is indefinite under 35 U.S.C. §112, second paragraph.

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Issue 1

Whether claims 1, 2, and 4 are anticipated by Eisener under 35 U.S.C. §102(b).

Claim 1

As to the claim element of “*performing a first assurance review of said first solution to determine whether said first solution is technically viable, deliverable, and includes technical risk identification, assessment, and containment plans*”, Appellants argued in the appeal brief that the Eisener reference does not disclose the determination of technical viability and deliverability of the first solution. In the Examiner’s Answer on page 9, lines 12-15, the Examiner argues: “It is inherent to any systems engineering process to ensure that the technical solution is viable and that the solution be deliverable to the client. Naturally, without feasible and deliverable solutions, the systems engineering project would most likely fail before finishing.”

In response, Appellants contend that the preceding “inherency” argument by the Examiner evidences an admission by the Examiner that Eisener does not explicitly disclose the determination of technical viability and deliverability of the first solution.

In addition, the preceding argument by the Examiner is vague and indefinite. To support an argument of inherency, the Examiner has to show that the inherency is inherently included within Eisener as a consequence of what Eisener actually discloses. However, the Examiner has not identified subject matter within Eisener, and associated supporting argumentation, that demonstrates the existence of the inherency. Accordingly, Appellants contend that the Examiner’s argument as to the existence of the inherency is not persuasive.

In addition, Appellants contend that the preceding argument by the Examiner is additionally defective, because claim 1 requires the determination of technical viability and

deliverability to be made during the step of performing a first assurance review, and the Examiner has not provided any argument as to why the allegedly inherent disclosure by Eisener of said determination of technical viability and deliverability relates to the step of performing a first assurance review as opposed to another step of the method of claim 1. Indeed, the Examiner has not even alleged that Eisener inherently teaches or suggests that said determination of technical viability and deliverability is inherently performed during the step of performing a first assurance review.

Furthermore, Appellants contend that the preceding inherencies alleged by the Examiner do not inherently exist in Eisener and they certainly do not inherently exist in the step of performing a first assurance review. For example, it is possible that viability and/or deliverability may be assumed by both the provider and the customer (e.g., based on previous experience between the provider and the customer, the nature of the customer's need, etc), so that a determination of viability and/or deliverability may be unnecessary and thus not performed. As another example, a determination of viability and/or deliverability does not have to be inherently performed in the step of performing a first assurance review as opposed to another step of the method. By ignoring these issues, the Examiner has not satisfied the Examiner's burden to prove anticipation.

Appellants additionally contend that the preceding "inherency" argument by the Examiner constitutes a new argument that was not present in the Office Action mailed 07/15/2002, and it was therefore was improper to include the preceding "inherency" argument in the Examiner's Answer.

As to the claim element of "*performing a second assurance review of said first solution*

to determine whether said first solution includes complete schedules, a complete cost and profit case, and said first solution satisfies both said provider business objectives and said customer need”, Appellants argued in the appeal brief that the Eisener reference does not disclose the following items: 1) whether said first solution includes complete schedules; 2) whether said first solution includes a complete cost and profit case; and 3) whether said first solution satisfies both provider business objectives and said customer needs. Appellants contend that the Examiner’s Answer does not persuasively address any of the preceding three items, and the Examiner admits that Eisener does not explicitly disclose any of the preceding three items in the Examiner’s Answer, as explained next.

The Examiner states on page 10, lines 15-21 of the Examiner’s Answer: “Although not explicitly disclosed as part of a second assurance review, scheduling is disclosed as an important factor in project management as shown in section 3.5, Schedule (pages 58-60). In addition, cost and profits are also considered as an integral part of the project life cycle, as disclosed in section 7..3.8, Life-Cycle Costing (pages 163-165). Inherently, as disclosed above, all matters and concerns must fall within provider objectives and customer needs.” Thus, the Examiner is using an “inherency” allegation without any supporting argument to support said allegation of inherency. The Examiner has provided no supporting argument as to why the three items (i.e., allegedly inherent inclusion of complete schedules, inclusion of cost and profit, and satisfaction of both provider business objectives and said customer needs) must inherently occur. As stated *supra*, to support an argument of inherency, the Examiner has to show that the inherency is inherently included within Eisener as a consequence of what Eisener actually discloses. However, the Examiner has not provided supporting argumentation that demonstrates the existence of the alleged inherencies based on the preceding sections of Eisener cited by the

Examiner. Accordingly, Appellants contend that the Examiner's argument as to the existence of the inherencies is not persuasive.

In addition, Appellants contend that the preceding argument by the Examiner is additionally defective, because claim 1 requires implementation of the preceding three items during the step of "performing a second assurance review of said first solution ...", and the Examiner has not provided any argument as to why the allegedly inherent disclosure by Eisener of said three items during the step of performing a second assurance review as opposed to another step of the method of claim 1. Indeed, the Examiner has not even addressed the issue of implementation of the preceding three items during the step of performing a second performance review.

Furthermore, Appellants contend that the preceding inherencies alleged by the Examiner do not exist in Eisener. Even if the Examiner were to argue that it is reasonable to include the preceding alleged inherencies in Eisener, Appellants contend that Eisener is free to not include something reasonable in his disclosure. Inclusion of the preceding alleged inherencies within Eisener has not been supported by the Examiner and reflects the Examiner's speculative personal opinion.

The Examiner states on page 10, lines 6-11 of the Examiner's Answer: "The application of the definitions above with regard to the instant invention applies to the assurance review steps associated with the first and second solutions. Obviously, if the solutions fail, one of the review processes, the quality of solution is called into question and the solution is repaired, altered, or *scrapped in favor of an alternative solution, unless it is not the intent of the engineering team to actually correct the deficiency.*" In response, Appellants contend that the preceding statement of what is allegedly "obvious" is not relevant, since under 35 U.S.C. §102, what is "obvious" is not

within the scope of 35 U.S.C. §102. Also, the Examiner's indication of what is "obvious" is not disclosed by Eisener at all, and certainly not disclosed as relating to the steps of performing a first and second assurance review. Appellants contend that the Examiner has not supported the Examiner's allegation of what is "obvious". In addition, the Examiner has not related what is allegedly obvious to any particular features of claim 1.

The Examiner states on page 10, lines 6-11 of the Examiner's Answer: "After reviewing the specification, namely page 5, it is the explicit understanding of the Examiner that the instant invention most assuredly does intend to include correction of deficiencies as identified by the first and second assurance reviews, inherently disclosing the recursive nature of the review process. Furthermore, the specification also discloses a periodic project management review for verification of various project goals and customer satisfaction, inherently disclosing the possibility of altering the solution sets." In response, Appellants contend that the preceding statement of the Examiner is irrelevant since the preceding statement of the Examiner relates to Appellant's specification and not to Eisener.

As to the claim element of "*performing a first readiness review of said second solution to identify new issues or risks which arose during said, obtaining customer commitment step, determine whether delivery plans are established, and establish baselines for performance and said profit case*", Appellants argued in the appeal brief that the Eisener reference does not disclose "to establish baselines for performance and profit" in the first readiness review of the second solution. The Examiner's Answer on page 10, line 22 - page 11, line 4 states: "Appellant also asserts that *performing a first readiness review of the second solution.. .to establish a baseline for performance and profit is not the same as Eisener's step of recomposing and refining*

the baseline concept.. Examiner respectfully disagrees. Since a baseline is nothing more than a standard or metric, wherein certain specifications are measured against, the baselining considered in Eisener is the same as in the claimed invention. Again, a review to check performance standards (metrics) and profitability (budgetary constraints) are **inherent** to a systems engineering design team” (emphasis added).

In response, Appellants contend that the preceding “inherency” argument by the Examiner evidences an admission by the Examiner that Eisener does not explicitly disclose establishing said baselines in the first readiness review of the second solution.

In addition, the preceding argument by the Examiner is vague and indefinite. To support an argument of inherency, the Examiner has to show that the inherency is inherently included within Eisener as a consequence of what Eisener actually discloses. However, the Examiner has not identified subject matter within Eisener, and associated supporting argumentation, that demonstrates the existence of the inherency. Accordingly, Appellants contend that the Examiner’s argument as to the existence of the inherency is not persuasive.

In addition, Appellants contend that the preceding argument by the Examiner is additionally defective, because claim 1 requires establishing said baselines in the **first readiness review** of the second solution, and the Examiner has not provided any argument as to why the allegedly inherent disclosure by Eisener of establishing said baselines is inherently performed during the step of performing a first readiness review as opposed to another step of the method of claim 1. Indeed, the Examiner has not even addressed the issue of the alleged establishing said baselines is inherently performed during the step of performing a first readiness review.

In addition, Appellants contend that the preceding statement by the Examiner is another unsupported inherency allegation in which the Examiner does not provide any argument as to

why Eisener inherently teaches establishing said baselines in the first readiness review **of the second solution**. The Examiner has not even considered the role of the second solution for establishing “a baseline for performance and profit” in claim 1.

Furthermore, Appellants contend that the preceding inherency alleged by the Examiner (for the step of performing a first readiness review) does not exist in Eisener. Even if the Examiner were to argue that it is reasonable to include the preceding alleged inherency in Eisener, Appellants contend that Eisener is free to not include something reasonable in his disclosure. Inclusion of the preceding alleged inherency within Eisener has not been supported by the Examiner and reflects the Examiner’s speculative personal opinion.

Appellants additionally contend that the preceding “inherency” argument by the Examiner constitutes a new argument that was not present in the Office Action mailed 07/15/2002, and it was therefore was improper to include the preceding “inherency” argument in the Examiner’s Answer.

As to the claim elements of “*periodically performing a project management review to verify said second solution is being managed as defined, meeting said profit case, and meeting said customer need*” AND “*thereafter, performing a deliverable readiness review to verify that said second solution has been delivered to said customer and that said second solution satisfies said customer need*” (emphasis added), the Examiner states on page 7, lines 2-10 of the Examiner’s Answer: “Eisener shows a Mission Design Review (Figure 7.2, Item 17) which is designed to ensure that each solution is on track and compliant with mission goals and objectives, In addition, the System Design Review (Figure 7.3, Item 14) ensures that the implementation of the solution is within technical specifications and guidelines, as derived from

customer needs and defined metrics. Quality Assurance and Management (QA&M), as disclosed in section . 7.3.20, pages 171-172, assures strict conformance with standards as dictated by the customer. **Inherently**, as shown above, each review is underpinned with the assumption that the customer's needs must be met accordingly" (emphasis added). In response, Appellants contend that the Examiner has again made an unsupported argument based on inherency. In addition, the Examiner has not even alleged that Eisener teaches the features of: "periodically performing a project management review to verify said second solution is being managed as defined" (emphasis added); and **thereafter**, performing a deliverable readiness review to verify that said second solution has been delivered to said customer " (emphasis added).

In summary, Appellants respectively assert that the Examiner's Answer is replete with unsupported arguments of inherency as well as neglect to consider whether Eisener teaches certain claim features as explained *supra*. Accordingly, and in view of other arguments made *supra* by Appellants, Appellants respectfully maintain that the rejection of claim 1 under 35 U.S.C. §102(b) is improper and should be reversed.

Claim 2

As to the claim feature of "*performing a third assurance review of said second solution to determine whether said deficiencies have been satisfactorily corrected*", the Examiner states in the Examiner's Answer: "Eisener shows three reviews during the engineering process (Figure 7.3, Items 5, 10, and 14). Although Eisener does not specifically disclose that a third review is intended determine whether said deficiencies have been satisfactorily corrected, it is the **inherent** nature of any reviewing process to uncover flaws, liabilities, or errors during the design phase

before the implementation and delivery phases of a product or service ..." (emphasis added). In response, Appellants contend that the Examiner has again made an unsupported argument based on inherency. Accordingly, Appellants respectfully maintain that the rejection of claim 2 under 35 U.S.C. §102(b) is improper and should be reversed.

Claim 4

As to the claim feature of "*wherein said first readiness review is performed by conducting a meeting to examine whether written delivery plans comprising communication delivery plans, organization delivery plans, tracking delivery plans, change control delivery plans, quality management delivery plans, and reporting delivery plans are all established*", the Examiner states in the Examiner's Answer: "Eisener discloses Training and Documentation i.e. communication (Section 7.3.25, page 174; Section 7.3.24, page 174); Systems Engineering Management i.e. organization (Section 7.3.30, pages 175-176); Operations and maintenance (O&M) i.e. tracking (Section 7.3.28, page 175); Preplanned Product Improvement (P31) i.e. change control (Section 7.3.23, pages 173-174); Quality Assurance and Management (QA&M) (Section 7.3.20, pages 171-172); and Installation i.e. delivery (Sections 7.3.27 and 7.3.30, pages 175-176). **Inherently**, each facet of the process takes the form of a written report during the evaluation meeting for the examination and convenience of all reviewing entities" (emphasis added). In response, Appellants contend that the Examiner has again made an unsupported argument based on inherency. Accordingly, Appellants respectfully maintain that the rejection of claim 2 under 35 U.S.C. §102(b) is improper and should be reversed.

Issue 2

Whether claim 4 is directed to non-statutory subject matter under 35 U.S.C. §101.

In the Examiner' Answer on page 3, lines 9–22 (and again on page 13, line 19 - page 14, line 10), the Examiner argues: "Dependent claim 4 cites limitations regarding a readiness review that is performed by conducting a meeting. Although the claimed subject may at times produce a useful and tangible result, it does not produce a concrete result. That is, the subject matter contained within the claims merely relates an intention to produce result i.e. tangible written reports or to verify the existence of said reports, but the results are not concrete because the outcome of the meeting is not predictable or repeatable. That is, the results of each meeting would most likely change from meeting to meeting. As affirmed above, the subject matter contained within the claims merely relates a thought process and not a physical device such as a computer or computer software that would produce or organize such written reports or establish whether the reports exist at all. Consequently, the claim language as. written does not meet the requirements for statutory subject matter."

In response, Appellants contend that the outcome of the meeting is concrete, since the result will be that either the written delivery plans are established (which is a concrete result) or that the written delivery plans are not established (which is likewise a concrete result). Appellants further contend that the outcome of the meeting is predictable, namely the predictable result that the written delivery plans are established or not established.

In addition, the Examiner has incorrectly argued that "the results of each meeting would most likely change from meeting to meeting". Appellants contend that at every meeting, it will always and predictably be found that either the written delivery plans are established or that the

written delivery plans are not established.

In addition, the Examiners allegation that “the claims merely relates a thought process and not a physical device such as a computer or computer software that would produce or organize such written reports or establish whether the reports exist at all” is not persuasive. Appellants contend that “conducting a meeting to examine whether written delivery plans … are all established” is an active method step and is not a thought process. The Examiner has not provided any analysis to support the Examiner’ contention that claim 4 relates to a thought process. Furthermore, the Examiner has not cited any authority or reference to support the Examiner’ allegation that in order to be statutory claim 4 would be required to claim “a computer or computer software that would produce or organize such written reports or establish whether the reports exist at all”. Thus, the Examiner’s arguments pertaining “a thought process” and to “a computer or computer software … “ are conclusory and not persuasive.

In the Examiner’ Answer on page 12, lines 11 - 12, the Examiner argues that “the Appellant is attempting to claim a meeting, which is non-statutory.” In response, Appellants contend that the preceding argument by the Examiner does not make sense, since claim 4 is not claiming a meeting, but is instead claiming “conducting a meeting”.

In the Examiner’ Answer on page 12, lines 12-13, the Examiner argues that “[a]s the claim is written, it is unclear what method/process Appellant is intending to encompass”. In response, Appellants contend that claim 4 clearly encompasses the process of “conducting a meeting” as is literally stated in claim 4, and Appellants are puzzled as to how the Examiner can find this to be unclear.

In the Examiner’ Answer on page 12, lines 13-17, the Examiner argues that “the process that is non-statutory in that the application of the intended plan is not defined. Examiner agrees

that business processes are patentable. However, the process must produce a useful, concrete, tangible result. As written, the limitations do not". In response, Appellants note that the preceding argument by the Examiner is contradicted by the Examiner's admission on page 11, lines 20-21, which recites: "the claimed subject may at times produce a useful and tangible result ...". Moreover, the Examiner has not provided any analysis to support the Examiner' contention (which the Examiner has contradicted as explained *supra*) that claim 4 does not produce a useful and tangible result. Thus, the Examiner has not satisfied the Examiner' burden of proof.

Appellants contend that the method of claim 4 results either in an outcome that the written delivery plans are established (which is a useful, concrete, and tangible result) or in an outcome that the written delivery plans are not established (which is likewise a useful, concrete, and tangible result).

Based on the preceding arguments as to why the Examiner's rejection of claim 4 under 35 U.S.C. §101 is improper, together with the insufficiency of the Examiner's Answer to Appellants arguments presented in the appeal brief, Appellants respectfully maintain that the rejection of claim 4 under 35 U.S.C. §101 is improper and should be reversed.

Issue 3

Whether claim 4 is indefinite under 35 U.S.C. §112, second paragraph.

In the Examiner' Answer on page 4, lines 5–8 (and again on page 13, lines 5-8), the Examiner argues that “dependent claim 4 does not disclose what one would expect to gain or gather once establishment or non-establishment of said written reports was confirmed. Consequently, the result of such a meeting does is vague and indefinite”. In response, Appellants contend that “what one would expect to gain or gather …” is irrelevant as to the issue of whether claim 4 is vague and indefinite under 35 U.S.C. §112, second paragraph. Appellants contend that “conducting a meeting to examine whether written delivery plans … are all established”, as claimed in claim 4, is clear and unambiguous. The result of such a meeting is likewise clear and unambiguous, since the result will be that either the written delivery plans are established (which is clear) or that the written delivery plans are not established (which is likewise clear).

In the Examiner' Answer on page 13, lines 12-13, the Examiner argues that “the Appellant is attempting to claim a meeting, which is non-statutory”. In response, Appellants contend that the preceding argument by the Examiner does not make sense, since claim 4 is not claiming a meeting, but is instead claiming “conducting a meeting”.

In the Examiner' Answer on page 13, lines 13-14, the Examiner argues that “[a]s the claim is written, it is unclear what method/process Appellant is intending to encompass”. In response, Appellants contend that claim 4 clearly encompasses the process of “conducting a meeting” as is literally stated in claim 4, and Appellants are puzzled as to how the Examiner can find this to be unclear.

In the Examiner' Answer on page 13, lines 14-17, the Examiner argues that “the process

that is non-statutory in that the application of the intended plan is not defined. Examiner agrees that business processes are patentable. However, the process must produce a useful, concrete, tangible result. As written, the limitations do not”. In response, Appellants contend that the preceding argument by the Examiner relates to the issue of whether claim 4 is non-statutory under 35 U.S.C. §101 as discussed *supra* in conjunction with Issue 2, and is totally irrelevant as to the issue of whether claim 4 is indefinite under 35 U.S.C. §112, second paragraph. 35 U.S.C. §112, second paragraph relates to whether claim 4 is indefinite and vague, and does not relate to whether implementation of claim 4 produce a useful, concrete, tangible result.

Appellants maintain the Examiner’s Answer fails to address Appellants argument presented in the appeal brief, namely that claim 4 requires that the readiness review performing step of claim 1 be “performed by conducting a meeting to examine whether written delivery plans ... are all established”. Thus claim 4 clearly limits the scope of the readiness review performing step of claim 1 in a clear and unambiguous manner.

Based on the preceding arguments as to why the Examiner’s rejection of claim 4 under 35 U.S.C. §112, second paragraph is improper, together with the insufficiency of the Examiner’s Answer to Appellants arguments presented in the appeal brief, Appellants respectfully maintain that the rejection of claim 4 under 35 U.S.C. §112, second paragraph is improper and should be reversed.

Summary

In summary, based upon the preceding arguments, Appellants respectfully request:
reversal of the rejection under 35 U.S.C. § 102(a) of claims 1, 2, and 4; reversal of the rejection
under 35 U.S.C. § 101 of claim 4; and reversal of the rejection under 35 U.S.C. § 112, second
paragraph of claim 4.

Respectfully submitted,

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